



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: ADMINISTRATIVE CENTER FOR PATENTS AND TRADEMARKS
Washington, DC 20591
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 393,844	09 10 1999	KATHERINE A. HIGH	10650 002002	3411

20985 7590 05 20 2002

FISH & RICHARDSON, PC
4350 LA JOLLA VILLAGE DRIVE
SUITE 500
SAN DIEGO, CA 92122

EXAMINER

SULLIVAN, DANIEL M

ART UNIT PAPER NUMBER

1636

DATE MAILED: 05 20 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/393,844

Applicant(s)

HIGH ET AL.

Examiner

Daniel Sullivan

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 08 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3 and 6-9 is/are rejected.
- 7) ☐ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-9 are pending in the application

This action is in response to the applicant's Amendment and Exhibits 1 and 2 mailed 5 June 2001.

Specification

The objections to the specification, as amended, are withdrawn.

Priority and Sequence Compliance

The current status of the priority document 09/038910, now US Pat. 6,093,392, is acknowledged, as is compliance with 37 CFR 1.821 through 1.825 for the disclosed sequences.

Claim Rejections - 35 USC § 112

Rejection of Claims 1 and 2 under 35 USC 112 is withdrawn. Rejection of Claim 5, as amended, under 35 USC 112 is also withdrawn.

Claim Rejections - 35 USC § 102

Rejection of Claims 1-3 and 6-8 under 35 USC 102(b) as being anticipated by Wiener (WO 96/15777) and under 35 USC 102(e) as being anticipated by Wilson et al (US 5,866,552) is withdrawn in view of the Declaration dated 23 May 2001 (Exhibit 1) stating that the invention was reduced to practice prior to 3 October 1995, as evidenced by Exhibit 2.

Art Unit: 1636

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3 and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Wiener et al US 6,342,390 issued 29 January 2002. Please note that the filing date for Wiener (23 November 1994) is prior to the date of reduction to practice claimed in Exhibit 1. The reasoning behind this rejection is the same as provided in the Office Action mailed 5 December 2001 (Paper Number 6; see page 6, anticipation by Wiener (WO 96/15777)).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Rejection of Claims 1-3 and 6-9 under 103(a) as being unpatentable over Wiener (WO 96/15777) in view of Crabtree et al. (U.S. Patent 5,834,266) or Skulimowski et al. in view of Kurachi et al., Webster et al., Theill et al., Kaufman and Roman et al. is withdrawn in view of Exhibits 1 and 2.

Art Unit: 1636

Claims 1-3 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner et al., as applied to claims 1-3 and 6-8, and in further view of Crabtree et al. US 5,834,266. Please note that the filing date for Weiner (23 November 1994) is prior to the date of reduction to practice claimed in Exhibit 1. The reasoning behind this rejection is the same as in the cited Office Action (see page 7, anticipation by Wiener (WO 96/15777) in view of Crabtree et al. (U.S. Patent 5,834,266)).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel M Sullivan whose telephone number is 703-305-4448. The examiner can normally be reached on Monday through Friday 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel can be reached on 703-305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-9105 for regular communications and 703-746-9105 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

dms
May 15, 2002


JAMES KETTER
PRIMARY EXAMINER